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2873

In re application of M. EGUCHI et al.

Attorney Docket No. P20339
Mail Stop Non-fee

Serial No. : 09/818,504

Group Art Unit: 2873

Filed : March 28, 2001

Examiner: S. Sugarman

For : A FOCUSING METHOD FOR ZOOM LENS SYSTEM

Mail Stop Non-Fee

COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Transmitted herewith is an election with traverse in the above-captioned application.

- Small Entity Status of this application under 37 C.F.R. 1.9 and 1.27 has been established by a previously filed statement.
- A verified statement to establish small entity status under 37 C.F.R. 1.9 and 1.27 is enclosed.
- A Request for Extension of Time.
- No additional fee is required.

The fee has been calculated as shown below:

Claims After Amendment	No. Claims Previously Paid For	Present Extra	Small Entity		Other Than A Small Entity	
			Rate	Fee	Rate	Fee
Total Claims: 11	20*	0	x 9=	\$	x 18=	\$0.00
Indep. Claims: 5	*5*	0	x 42=	\$	x 84=	\$0.00
Multiple Dependent Claims Presented			+140=	\$	+280=	\$0.00
Extension Fees for Month				\$		\$0.00
			Total:	\$	Total:	\$0.00

*If less than 20, write 20

**If less than 3, write 3

Please charge my Deposit Account No. 19-0089 in the amount of \$_____.

N/A A Check in the amount of \$_____ to cover the *filing/extension* fee is included.

The U.S. Patent and Trademark Office is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 19-0089.

Any additional filing fees required under 37 C.F.R. 1.16.

Any patent application processing fees under 37 C.F.R. 1.17, including any required extension of time fees in any concurrent or future reply requiring a petition for extension of time for its timely submission (37 CFR 1.136) (a)(3)

Linda Hodge Reg No 47348
Bruce H. Bernstein
Reg. No. 29,027

P20339.A04



#5 QB
7/28/03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : M. EGUCHI et al.

Group Art Unit: 2873

Appl. No. : 09/818,504

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For : A FOCUSING METHOD FOR ZOOM LENS SYSTEM

RESPONSE TO RESTRICTION REQUIREMENT WITH TRAVERSE

Commissioner for Patents
PO Box 1450
Alexandria, Virginia 22313-1450

Sir:

In response to the Examiner's restriction requirement dated June 20, 2003, setting a one month period for response extending until July 21, 2003 (July 20, 2003 being a Sunday), Applicants elect, with traverse, the invention identified by the Examiner as Group I, a three group zoom lens system, including claims 1-7 and 9.

Applicants respectfully traverse the Restriction Requirement. The Examiner has characterized the inventions of Groups I (claims 1-7 and 9); II (claim 8); III (claim 10); and IV (claim 11) as "unrelated". The Examiner has stated in the restriction requirement that the inventions are unrelated in accordance with MPEP §§ 806.04 and 808.01, since "the different inventions have different modes of operation, since they all have separately classifiable structure". However, Applicant respectfully submits that, even assuming, arguendo, that the

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claims of Groups I, II, III, and IV recite “separately classifiable structure”, it does not necessarily follow that the inventions also have “different modes of operation”. Further, it is also submitted that the inventions claimed in the claims of Groups I, II, III, and IV do not have “different modes of operation” since all of the claims recite a focusing method for a zoom lens system including operating a lens group or a plurality of lens groups as a focusing lens group.

Moreover, as stated by the Examiner, two or more inventions may be independent if two different combinations, not disclosed as capable of use together, have different modes of operation (MPEP § 806.04(A)). However, also according to MPEP § 806.04(A), “[a]n article of apparel such as a shoe, and a locomotive bearing would be an example. A process of painting a house and a process of boring a well would be a second example”. Therefore, only completely disparate groups of inventions that are different in kind may be classified as “independent” and unrelated. In the present application, all of the claims of Groups I, II, III, and IV are directed to a focusing method for a zoom lens system. Thus, Groups I, II, III, and IV are all clearly related.

Further, MPEP § 808.01, also referred to by the Examiner, states that the situation in which claimed inventions will be properly classified as independent (*i.e.*, where they are not connected in design, operation, or effect under the disclosure) “except for species, is but rarely presented, since persons will seldom file an application containing disclosures of

independent things". Since the inventions claimed in Groups I, II, III, and IV in the present case are all directed to a focusing method for a zoom lens system, it is respectfully submitted that the present case is not one of the rarely presented instances in which independent inventions have been presented. Accordingly, at least for the above reasons, it is respectfully requested that the Examiner reconsider and withdraw the restriction requirement.

Additionally, even if the Examiner's characterization of Groups I, II, III, and IV as defining unrelated inventions were to be considered correct, Applicants respectfully request that all of the inventions defined in claims 1-11, nevertheless, be examined in the instant application, pursuant to the guidelines set forth in MPEP § 803. That is, the Examiner is respectfully requested to reconsider the requirement and find that there would not appear to be a "serious burden" on the Patent and Trademark Office in examining claims directed to the non-elected inventions since the Examiner will have to search for the focusing methods of claims 8, 10, and 11 while searching for the focusing method of claims 1-7 and 9.

It would appear that the search for the inventions identified by the Examiner would be coextensive or at least significantly overlap. That is, if the Examiner were to perform a search for the invention of Group I, there would not appear to be a serious burden in continuing the examination of the other inventions of Groups II, III, and IV. For this reason, and consistent with office policy as set forth in MPEP § 803, Applicants respectfully request that the Examiner reconsider and withdraw the Requirement for Restriction.

Should there be any questions, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
M. EGUCHI et al.

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July 9, 2003
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